



UNITED STATES DEPARTMENT OF COMMERCE
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08/314,734 09/29/94 BOTTCHE

H MERCK1617

BERNHARD EXAMINER

12M2/1025
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ART UNIT PAPER NUMBER

1202

DATE MAILED: 10/25/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 6/30/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-28 are pending in the application.
Of the above, claims 13, 19-22 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-12, 14-15, 17-18, 23 and 27 are rejected.
5. ☒ Claims 16, 24-25 and 28 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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In view of applicants' response filed 06/30/95 the following applies.

Applicants' election of Group I subject matter with traverse is acknowledged but is not persuasive for reasons previously set forth-see page 3 of previous office action. The field of search in the U.S. Classification is completely independent for the two Z groups and where multiple uses exist restriction is proper between compounds (and compositions) vs. multiple uses-see MPEP 806.05(h). Different uses raise different issues of patentability over corresponding compound/composition claims. Note In re May 197 USPQ 601; In re Shetty 195 USPQ 753.

For the above reasons the restriction is deemed proper and is therefore made FINAL.

Claims 1-11 and 17-18 are rejected under judicial doctrine as being drawn to an improper Markush group for reasons of record. Unlike Harnisch, 206 USPQ 300 cited by applicants, the pharmaceutical art does not recognize the instant Z moieties ^{as} ~~on~~ equivalent. Note Bottcher and Perregaard ~~dant~~. Note that in Harnisch the various substituents defined by NZ^1Z^2 were held to be incidental, the coumarin core responsible for the dye activity. In contrast to Harnisch, there is no evidence of record that either the instant indolyl and/or bicyclic oxygen heteros common to both groups contributes solely to the physiological activity. Clearly if only the former ring system

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(indole) and piperazine ^{are} ~~and~~ predominately responsible for the activity, Bottcher applied previously and maintained below cannot be overcome. Note In re Milas 71 USPQ 212 in which the structural difference between Vitamin A and Vitamin D was sufficient to uphold the improper Markush rejection. Also see In re Winnek, 73 USPQ 225 and In re Ruzicka, 66 USPQ 226 which structural differences were small yet a similar holding was maintained. All these cases involved compounds in the pharmaceutical art known to be structure-sensitive in general.

This application contains claims drawn to an invention non-elected with traverse in Paper No. 5. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P.

§ 821.01.

Claims 1-12, 14-15, 17-18, 23, 26, and 27 are rejected under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Perregaard for reasons of record - see previous action.

The issue date of Boettcher is one year earlier than the instant U.S. filing date. Thus Boettcher can't be antedated even if benefit under 35 USC 119 exists. See MPEP 201.13, p. 200-28, left column entitled "Effect on Right of Priority", Rev. January 1995.

Applicant's arguments filed 6/3/95 have been fully considered but they are not deemed to be persuasive.

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Contrary to what applicants seem to infer a claim is properly rejected once any part of its instant scope is anticipated or rendered obvious by a competent reference. While R^1 as chromenyl or chromen-4on-6yl or benzofuranyl or chroman-4-on-6-yl is not suggested by the combined teachings of Boettcher and Perregaard, R^1 as dihydro benzofuran-5-yl or chroman-6-yl is. Applicants urge Perregaard is too structurally remote since point of attachment to piperazine ring is at a different location ~~ex~~ on benzene ring than is claimed herein. While this is correct, note that Boettcher, the primary reference teaches attachment of fused benzene ring system at the same location as herein. Perregaard was only relied on to show that benzodioxane can be replaced with instant R^1 rings as discussed above in similar compounds and still retain activity disclosed in Boettcher. Furthermore, it is not believed the disclosure of Perregaard is too diffuse since the pertinent rings embraced in Ar is not an infinite Markush group but rather narrow in scope. For the above reasons the rejection is maintained.

Claims 1-12, 14-15, 17-18, 23, and 26-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5242925 in view of Perregaard for reasons of record. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons

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as discussed previously in the corresponding 103 rejection and discussed above. Note the inclusion of claims 19-22 in this rejection in the previous action was inadvertent.

Claims 16, 24-25, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant is again reminded that if non-elected subject matter is deleted many claims will be superfluous as well as "Z is N" recitation in various dependent claims.

Böttcher, US '237, recently issued and commonly assigned is cited to show the state of the art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine is (703) 308-4556 or 305-3592.

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Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

BERNHARDT:jd
OCTOBER 18, 1995

E Bernhardt
EMILY BERNHARDT
PRIMARY EXAMINER
GROUP 120